

This rejection is directly contrary to the PTO's interim guidelines for examination under §101 printed in the November 22, 2005 Official Gazette Notices. The interim guidelines clearly state that the "mental step" or "human step" tests are not valid tests for determining whether a claimed invention recites statutory subject matter under §101 (see Annex III, "Improper Tests for Subject Matter Eligibility").

Rather, the test for whether a claim produces a tangible result under §101 only requires that "the claim must produce a real-world result." The guidelines define a real-world result as "a practical method or means of producing a beneficial result or effect." Thus, according to the PTO's interim guidelines for examination under §101, a method claim need only produce a beneficial result or effect to satisfy the "tangible" requirement of §101. The method of claim 21 beneficially produces a layout of published information and thus produces a beneficial result or effect. Accordingly, claim 21 recites statutory subject matter under §101. Applicants respectfully request withdrawal of the rejection.

The Office Action rejects claims 1-21 under 35 U.S.C. § 102(e) over U.S. Patent No. 6,453,302 to Johnson et al. (hereinafter "Johnson"). Applicants respectfully traverse the rejection.

Johnson fails to at least disclose that the information to be published is selected first, and then the template is selected to fit the information, as recited in claims 1, 2, 6, 10, 14, and 21.¹ In particular, in Johnson, the template is selected first, based on the purpose of the presentation (see e.g., Fig. 3, step 306). That is, for example, a cover page template 400 is selected to present introductory information (C10/L12-27). After selection of the template, information is selected to fill the template, such as a cover story graphic 408, an overview of

¹ Applicants note that the order of the steps is not explicitly recited in claims 1, 2, 6, 10, 14, and 21; however, each of those claims require that the layout be selected based on one or more aspects of the published information. Thus, according to claims 1, 2, 6, 10, 14, and 21, the published information must be selected prior to the template.

the proposal 414, etc. (Fig. 3, step 308, C10/L28-37). Accordingly, Johnson discloses the exact opposite order of steps as the claimed invention. Thus, Johnson cannot reasonably be considered to disclose that the information to be published is selected first, and then the template is selected to fit the information.

Because Johnson fails to at least disclose that the information to be published is selected first, and then the template is selected to fit the information, claims 1, 2, 6, 10, 14, and 21 are patentable over Johnson. Further, claims 2-5, 7-9, 11-13, and 15-20 are patentable for at least the reasons that claims 1, 2, 6, 10, and 14 are patentable, as well as for the additional features they recite. Applicants respectfully request withdrawal of the rejection.

In view of at least the foregoing, Applicants respectfully submit that this application is in condition for allowance. Applicants earnestly solicit favorable reconsideration and prompt allowance of claims 1-21.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, Applicants invite the Examiner to contact the undersigned at the telephone number set forth below.

Respectfully submitted,


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